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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,538	03/17/2004	Brian Labrec	38820-510C01US	5669
36623 7590 07/22/2009 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C ONE FINANCIAL CENTER BOSTON, MA 02111				
EXAMINER NILAND, PATRICK DENNIS				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
07/22/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/803,538

Applicant(s)

LABREC, BRIAN

Examiner

Patrick D. Niland

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/4/09 has been entered.

The amendments of 5/4/09 and 10/28/08 have been entered. Claims 1-15 and 26 are pending.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-15 and 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 and 9-10 of copending Application No. 10/677,092. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the explanation given in paragraph 4 of the office action mailed 12/8/06 which is incorporated here by reference. It is not seen that the method steps of composition claim 26 distinguish the composition of the copending claims from that of claim 26 of the instant application. Since the additives of the copending claims and the instant claims appear to be used for the same purposes, it is expected that they must be used in the same amounts. No unexpected results are seen for the instantly claimed amounts in a manner commensurate in scope with the instant claims and the cited prior art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. It is noted that the copending claims have been allowed but not yet issued in a patent. The copending application is the earlier filed. This application cannot issue without terminal disclaimer or abandonment of the copending, allowed application. See MPEP 804 regarding the argument that the above obviousness type double patenting rejection does not prevent this application from being issued.

Applicants state that they are going to defer response on the above double patenting rejection until issuance of at least one of the applications involved. The applicant does not point out any reasons why the above rejection is not correct.

It is noted that until issuance of the copending application, the above rejection is maintained against the present claims. After issuance, the provisional rejection will be made non-provisional.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-15 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of US Pat. No. 5840142 Stevenson et al., US Pat. No. 5374675 Plachetta et al., US Pat. No. 5075195 Babler et al. and US Pat. No. 3825317 Inoue et al..

The cited prior art is all directed to marking polymer compositions with high energy sources though Stevenson does not disclose laser marking. The prior art is seen as being analogous therefore.

Stevenson discloses the instantly claimed compositions containing the instantly claimed polymers and pigments including barium or cadmium sulfides (column 3, lines 6-8) except that they do not contain the instantly claimed copper potassium iodide nor copper iodide.

Plachetta discloses laser inscribable compositions of the instantly claimed polymers, copper iodides (column 3, lines 60-61), and pigments (column 3, lines 32-54), which fall within

the scope of the instantly claimed compound of claim 7 of the instant application due to the affect of said pigments on light by definition of pigment, but no metal sulfides. The compounds of column 3, lines 32-56 are all expected to fall within the scope of the instant claim 7 also since some enhanced property is expected from each additive or it would not have been used.

Babler discloses laser marking compositions containing the instantly claimed polymers, molybdenum disulfide, pigments, and additives used in the plastics art, including additional colorants and antioxidants and heat stabilizers (column 4, lines 44-55), except that they do not contain the instantly claimed copper potassium iodide nor copper iodide.

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the copper iodide of Plachetta with the compositions of Stevenson and/or Babler because the copper iodide would have been expected to give its antioxidant and/or heat stabilizing affects to the compositions of Stevenson and/or Babler and Stevenson and/or Babler encompass the use of such auxiliaries as stated above. The amount of Plachetta, column 3, lines 57-66 fall within the scope of the instant claims 1, 4-6, and 9-10. It is not seen that the processing steps of the instant claims give a different composition than that of the prior art discussed above. See MPEP 2112-2113. It is not seen that the above discussed polymeric compositions do not necessarily have the instantly claimed abilities of the instant claims 3, 11-12, and 14-15 due to the polymers used therein. Column 4, lines 35-36 of Babler implies the step of the instant claim 13.

Alternatively, it would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the metal sulfide pigments of Stevenson and/or Babler in the compositions of Plachetta because they are broadly encompassed by Plachetta's disclosure

of using pigments and would have been expected to give their known pigmenting properties to the final compositions of Plachetta.

Since the laser marking of Plachetta will give heat and/or oxidation necessarily and inherently due to the energy of the laser that can mark polymer, heat stabilization and antioxidation clearly has something to do with laser inscribing. This argument of the applicant is not material in any event since Plachetta in fact discloses the use of these compounds in compositions which are to be laser inscribed. Applicant's arguments regarding use of copper iodide in Plachetta do not overcome the fact that Plachetta in fact discloses the use of these compounds in compositions which are to be laser inscribed. The teaching away argument cannot overcome this because Plachetta has not teaching away disclosures and teaches the use of the copper iodide. These arguments are not persuasive for this reason.

Arguments to the copending application's reference to antioxidants etc. are not persuasive because that application is not under examination here and Plachetta teaches the actual use of the copper iodide in compositions to be laser inscribed. The instant claims are directed to compositions, not laser inscribing grey scales argued by the applicant. There is not teaching that the laser inscribing of greyscales cannot be done on any of or the combinations of the prior art compositions. It is particularly expected that it can given the disclosure of laser inscribing the compositions of Plachetta and Babler and because this limitation is seen as having much to do with the technique of laser inscribing as with the compositions to be inscribed. The applicant provides not probative evidence that the above discussed composition would not be laser inscribable with the gray scale as claimed.

The above rejection meets the requirements of *Graham v. Deere*, with the pertinent factors being specified in the above rejection. See MPEP 2141, particularly the KSR decision therein. The examiner disagrees with what the applicant alleges the ordinary skilled artisan to consider regarding antioxidants and heat stabilizers verses laser enhancing additives for the reasons stated above regarding Plachetta.

The rationale to use the components of Stevenson in laser encribed compositions of the instant claims is found in Plachetta and Babler as noted above. Applicant's arguments in this regard are therefore not persuasive.

The applicant has demonstrated no unexpected results stemming from the instantly claimed compositions over the prior art cited in a manner commensurate in scope with the cited prior art and the instant claims.

The argued KSR decision is seen as supporting the instantly claimed rejection, particularly in view of the above stated reasons for combining the cited prior art. See MPEP 2141.

Inoue discloses the instantly claimed compounds as being effective to enhance laser engraving responsiveness of the polymer material inherently in their disclosure that the instantly claimed copper compounds and sulfides are photosensitive materials that respond to laser at column 1, lines 1-25, particularly 22-25; column 2, lines 1-44; column 3, lines 19-36, 37-59, and 60-68; column 4, lines 1-25, particularly 1-2, which encompasses the instantly claimed sulfides, and 14-18, which shows that copper, halides, and potassium compounds are such photosensitive compounds, such that the instantly claimed copper compounds are expected to give the instantly claimed enhanced laser engraving responsiveness because they are stated to be responsible for

the action by which the coherent light, i.e. laser, of Inoue gives the hologram image, i.e. laser engraving. See also column 5, line 64 to column 6, line 1 noting the intermetallic compounds of copper and the CuI. The copper compounds and sulfide compounds of the cited prior art would have therefore been expected to enhance the laser engraving responsiveness of the disclosed compositions and give the properties the other cited prior art attribute to the instantly claimed copper compounds and sulfides.

The applicant's arguments have been fully considered but are not persuasive for the above reasons, which specifically or inferentially rebut the applicant's arguments. This rejection is therefore maintained.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Friday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Patrick D Niland/
Primary Examiner
Art Unit 1796